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William L. Thomas

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EXAMINER

CHOWDHURY, SUMAIYA A

ART UNIT

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2421

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/974,529	<b>Applicant(s)</b> THOMAS ET AL.	
	<b>Examiner</b> SUMAIYA A. CHOWDHURY	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant argues "Instead, Shoff requires that the supplemental content be specifically requested either by the user or the system at the user device and is thus not retrieved in response to a request for on-demand media" on page 4, second paragraph of the Remarks filed 2/26/09.

The Examiner agrees and has therefore brought in Slezak to this limitation.

### ***Claim Objections***

2. Claims 94 and 95 are objected to because of the following informalities:

In claim 94, line 2, change "in claim 76" to --in claim 93--.

In claim 95, line 2, change "in claim 94" to --in claim 93--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 94 and 95 recite the limitation "the interactive media" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 11-14, 18, 23-25, 26-34, 36-39, 43, 48-59, 61-64, 68, 73-84, 86-89, 93, and 98-100, are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (6006257) in view of Kitsukawa (6282713).

As for claims 1, 26, and 76, Slezak discloses a method, system, and processor readable medium comprising:

Means for receiving a request for on-demand media from a user at a user equipment device (User selects primary program (i.e. movie). col. 5, lines 37-53)

Means for transmitting the request to a remote server means (col. 5, lines 37-53);

At the remote server means:

Means for receiving the request for the on-demand media from the user equipment device (col. 5, lines 37-53);

Means for identifying supplemental content (secondary programming) that is related to the on-demand media in response to the request for on-demand media (col. 10, lines 27-35, col. 4, lines 4-6, lines 14-29);

Means for retrieving the identified supplemental content related to the on-demand media in response to the request for on-demand media (col. 5, lines 46-50, col. 9, lines 4-20);

Means for providing the on-demand media and the supplemental content from the remote server to the user equipment device means in response to the request for on-demand media (col. 10, line 61-col. 11, line 3);

Slezak further discloses receiving a request to view supplemental content and providing the supplemental content in response to the request (col. 9, lines 37-55) but fails to disclose:

Means for receiving a request to view the supplemental content from the user at the user equipment device means, wherein the request to view the supplemental content is received while the user is viewing the on-demand media; and

Means for providing the supplemental content to the user in response to the request for supplemental content.

In an analogous art, Kitsukawa discloses:

Means for receiving a request to view the supplemental content from the user at the user equipment device means, wherein the request to view the supplemental content is received while the user is viewing the on-demand media (col. 2, lines 24-61);and

Means for providing the supplemental content to the user in response to the request for supplemental content (col. 2, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak's invention to include the above mentioned limitation, as taught by Kitsukawa, for the advantage of allowing the user to select their own advertising to view, thereby providing user customization of programming.

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As for claims 2, 27, 52, and 77, Slezak discloses wherein the on-demand media is video-on-demand – col. 5, lines 37-53.

As for claims 3, 28, 53, and 78, Kitsukawa discloses indicating the availability of supplemental content to the user (col. 8, lines 16-40).

As for claims 4, 29, 54, and 79, Kitsukawa discloses providing a visual indicator (advertising mark) of the availability of supplemental content (col. 8, lines 16-40).

As for claims 5, 30, 55, and 80, Kitsukawa discloses wherein the visual indicator is selected from the group consisting of graphics (col. 8, lines 16-40).

As for claims 6, 31, 56, and 81, Slezak discloses:

Detecting when media on a digital storage device is accessed; Providing the user with the media in response to the detection (col. 8, lines 20-48);

Kitsukawa teaches:

Receiving a request for supplemental content related to the media on the digital storage device; Retrieving the supplemental content that is related to the media on the digital storage device; and Providing the supplemental content that is related to the media on the digital storage device to the user (col. 2, lines 24-61).

As for claims 7, 32, 57, and 82, Slezak discloses providing the supplemental content comprises providing supplemental content concurrently with the on-demand media (col. 10, line 61-col. 11, line 3).

As for claims 8, 33, 58, and 83, Slezak discloses providing supplemental content separately from the on-demand media (col. 4, lines 29-44).

As for claims 9, 34, 59, and 84, Slezak discloses retrieving supplemental content prior to viewing the on-demand media (col. 10, line 61-col. 11, line 3).

As for claims 11, 36, 61, and 86, Kitsukawa discloses retrieving supplemental content comprises storing supplemental content (col. 2, lines 24-61).

As for claims 12, 37, 62, and 87, Kitsukawa teaches retrieving supplemental content comprises locally caching the supplemental content associated with the on-demand media (col. 6, lines 5-11).

As for claims 13, 38, 63, and 88, Slezak discloses wherein the supplemental content is synchronous metadata (col. 10, line 61-col. 11, line 3, col. 5, lines 46-50, col. 9, lines 4-20).

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As for claims 14, 39, 64, 89, Kitsukawa discloses:

providing the user with at least one option related to supplemental content; and  
receiving an indication of the at least one option from the user (col. 8, lines 16-40).

As for claims 18, 43, 68, and 93, Kitsukawa discloses:

providing the supplemental content comprises providing interactive media related  
to the on-demand media (ads are related to the programming; col. 2, lines 24-61).

As for claims 23, 48, 73, and 98, Kitsukawa discloses providing links to  
supplemental content related to the on-demand media (col. 8, lines 50-58).

As for claims 24, 49, 74, and 99, Slezak fails to disclose:

providing the user with at least one option related to the on-demand media; and  
receiving an indication of the at least one option from the user (col. 9, lines 38-56, col. 4, lines 14-35).

As for claims 25, 50, 75, and 100, Kitsukawa discloses providing the  
supplemental content while the user is viewing the on-demand media (col. 8, lines 20-36).



Claim 51 contains limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Claim 51 additionally calls for the following which Slezak teaches:

a user input device (col. 8, lines 10-13);

a display device (502- fig. 1);

6. Claims 10, 35, 60, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa as applied to claim 1 above, and further in view of Swix.

As for claims 10, 35, 60, and 85, Slezak and Kitsukawa fail to teach retrieving supplemental content comprises retrieving supplemental content prior to viewing the on-demand media using a carousel approach.

In an analogous art, Swix teaches retrieving supplemental content comprises retrieving supplemental content prior to viewing the on-demand media using a carousel approach (col. 9, lines 38-45, col. 13, lines 42-48).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include the above mentioned limitation, as taught by Swix, for the advantage of allowing the set-top receiver to tune to the data stream at any instant, thereby reducing the user's wait time.

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7. Claims 19, 44, 69, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa in view of Kambayashi.

As for claims 19, 44, 69, and 94, Slezak and Kitsukawa fail to teach:

wherein the interactive media is a survey.

In an analogous art, Kambayashi discloses wherein the interactive media is a survey (col. 21, line 49 – col. 22, line 5).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include the above mentioned limitation, as taught by Kambayashi, for the advantage of allowing users to voice their opinion/vote.

8. Claims 15-17, 20, 40-42, 45, 65-67, 70, 90-92, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa as applied to claim 1 above, and further in view of Shoff.

As for claims 15-17, 40-42, 65-67, and 90-92, Slezak and Kitsukawa fail to disclose providing an actor interview/information related to an actor the user is currently watching.

In an analogous art, Shoff discloses providing an actor interview/information of an actor (col. 11, lines 26-34).

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include the above mentioned limitation, as taught by Shoff, for the advantage of providing the user with additional information regarding the actor.

As for claims 20, 45, 70, and 95, Slezak and Kitsukawa fail to disclose wherein the interactive media is an interactive game.

In an analogous art, Shoff discloses wherein the interactive media is an interactive game (col. 5, lines 12-22).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include the above mentioned limitation, as taught by Shoff, for the advantage of providing the user with various types of entertainment.

9. Claims 21, 46, 71, and 96 rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa in view of Reimer.

As for claims 21, 46, 71, and 96, Slezak and Kitsukawa fail to teach providing information related an audio portion of the on-demand media.

In an analogous art, Reimer discloses wherein the user selects to view a scene while listening to voice overs of director or actor with their comments about the scene - col. 5, lines 48-52.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include providing information related an audio portion of the on-demand media, as taught by Reimer, for the advantage of providing the user with supplemental audio content.

10. Claims 22 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa in view of Reimer and Portuesi.

As for claims 22 and 47, Slezak, Kitsukawa, and Reimer fail to disclose providing links related to the audio portion of the on-demand media.

In an analogous art, Portuesi discloses wherein the URLs are associated with the audio in the movie file – col. 5, lines 60-67.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak, Kitsukawa, and Reimer's invention to include wherein the URLs are associated with the audio portion in the movie file, as taught by Portuesi, for the advantage of providing the user with the additional feature of accessing desired audio files by simply clicking on a link.

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11. Claims 72 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak and Kitsukawa in view of Portuesi.

As for claims 72 and 97, Slezak and Kitsukawa fail to disclose providing links related to the audio portion of the on-demand media.

In an analogous art, Portuesi discloses wherein the URLs are associated with the audio in the movie file – col. 5, lines 60-67.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Slezak and Kitsukawa's invention to include wherein the URLs are associated with the audio portion in the movie file, as taught by Portuesi, for the advantage of providing the user with the additional feature of accessing desired audio files by simply clicking on a link.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUMAIYA A. CHOWDHURY whose telephone number is (571)272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sumaiya A Chowdhury/  
Examiner, Art Unit 2421

/Annan Q Shang/  
Primary Examiner, Art Unit 2424